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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/527,727	09/26/2005	Jochen Wonschik	3968.150	8867
30448	7590	03/24/2009		
AKERMAN SENTERFITT P.O. BOX 3188 WEST PALM BEACH, FL 33402-3188				
EXAMINER				
MERCER, MELISSA S				
ART UNIT		PAPER NUMBER		
1615				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/527,727

**Applicant(s)**

WONSCHIK ET AL.

**Examiner**

MELISSA S. MERCIER

**Art Unit**

1615

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 15 January 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-11 and 13-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11, 13-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)  
Paper No(s)/Mail Date \_\_\_\_\_

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Summary***

Receipt of Applicants Remarks and Amended claims filed on January 15, 2009 is acknowledged. Claims 1-11 and 13-21 remain pending in this application.

### ***Withdrawn Rejections***

#### ***Claim Rejections - 35 USC § 103***

The rejection of claims 1-5, 11, 14-17, and 21 under 35 U.S.C. 103(a) as being unpatentable over Pearce (US 20050100640) in view of Halik et al. (US Patent 4,241,092) and further in view of Stapler et al. (US Patent 5,286,496) has been withdrawn in view of Applicants Amendment to claim 1 limiting the plasticizer to only a glycerol, propylene glycol, sorbitol, maltitol, and combination thereof, which is present in the amount of 10-30%.

The rejection of claims 6-9, 13, and 18-20 under 35 U.S.C. 103(a) as being unpatentable over Pearce (US 20050100640) in view of Halik et al. (US Patent 4,241,092) and Stapler et al. (US Patent 5,286,496) in view of Alamian et al. (US Patent 6,770,311) has been withdrawn for the same reasons as stated above.

The rejection of claim 10 under 35 U.S.C. 103(a) as being unpatentable over Pearce (US 20050100640) in view of Halik et al. (US Patent 4,241,092) and Stapler et al. (US Patent 5,286,496) in view of Greenberg (US Patent 5,378,131) has been withdrawn for the same reasons as stated above.

***Newly Applied Rejections***

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-11 and 13-21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is unclear what the designation (m/m) is meant to convey. The Examiner has interpreted it to be (w/w), as in mass/mass. Clarification is requested.

***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-11 and 13-21 are rejected under 35 U.S.C. 103(a) as being obvious over Schleifenbaum et al. (US Patent 7,226,613) in view of Rowe et al. (US Patent 6,200,603).

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject

matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). This rejection might also be overcome by showing that the reference is disqualified under 35 U.S.C. 103(c) as prior art in a rejection under 35 U.S.C. 103(a). See MPEP § 706.02(I)(1) and § 706.02(I)(2).

Schleifenbaum discloses Spherical capsule having a liquid core and a seamless solid shell surrounding the core, in which: the diameter of the capsule is in the range of 4-8 mm; the thickness of the shell is in the range of 20-200  $\mu\text{m}$ ; the shell thickness to capsule diameter ratio is in the range of 0.004-0.04; the shell contains 70-90% (m/m) gelatin and 10-30% (m/m) plasticizer, based on the solids content of the shell; and the core has a flavoring content in the range of 1-100% (m/m), based on the total mass of the core (abstract). The plasticizers are polyols, such as sorbitol, glycerol, and propylene glycol, for example (column 8, lines 1-4).

Regarding claims 6 and 18-19, the gel points of preferred shell mixtures are between 15C and 60C (column 5, lines 42-45).

Regarding claims 7-9, 13, and 20, a gelatin having a Bloom value of more than 200, particularly preferentially having a Bloom value of 240-300 (column 6, lines 7-8).

Regarding claims 10 and 14, the liquid core can further comprise a sweetener such as thaumatin, neohesperidine, miraculin, saccharinic acid and acesulfame K (column 11, lines 10-20).

Regarding claims 15-16, gellan gum can be added into the shell the range of 0.4-3% (m/m) based on the solids content of the shell (column 10, lines 30-35).

Regarding claim 17, with the exception of a coating being applied, the same method of preparation is disclosed in claim 18.

Schleifenbaum does not disclose a coating on the capsules comprising at least one sugar or sugar alcohol or an intermediate layer of gum Arabic, maltadextrin, starch, sugar, sugar alcohol, gelatine, or mixtures thereof.

Rowe discloses capsules having flavored coatings (title). The coating is based on sugar or sugar substitute and is typically applied to capsules as an aqueous solution in, for example, a panning process (column 3, lines 12-15). It is the position of the Examiner that a pan coating would necessarily result in a seamless solid coating and a smooth surface. The examples further disclose the coating comprises approximately 33% sorbitol (Column 4). The thickness of the coating would be within the skilled artisans knowledge to optimize based on the number of layers employed during the panning process.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have used the coating of Rowe on the capsules of Schleifenbaum since it is disclosed by Rowe that the coating serves to reinforce the

shell (column 3, lines 31-32) and enables a substantially dry coating to be created which does not draw the water or plasticizer from the gelatin shell (column 1, lines 51-53).

It is also noted that the instant Application and the Schleifenbaum has a common assignee. The cited art of was not submitted on an Information Disclosure Statement and made of record in the instant application. Applicant is reminded of their duty to disclose any know art that may be relevant to the instant application.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thornton*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-11 and 13-21 rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-22 of U.S. Patent No. 7,226,613 in view of Rowe et al. (US Patent 6,200,603).

Schleifenbaum does not disclose a coating on the capsules comprising at least one sugar or sugar alcohol or an intermediate layer of gum Arabic, maltadextrin, starch, sugar, sugar alcohol, gelatine, or mixtures thereof.

Rowe discloses capsules having flavored coatings (title). The coating is based on sugar or sugar substitute and is typically applied to capsules as an aqueous solution in, for example, a panning process (column 3, lines 12-15). It is the position of the Examiner that a pan coating would necessarily result in a seamless solid coating and a smooth surface. The examples further disclose the coating comprises approximately 33% sorbitol (Column 4). The thickness of the coating would be within the skilled artisans knowledge to optimize based on the number of layers employed during the panning process.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have used the coating of Rowe on the capsules of Schleifenbaum since it is disclosed by Rowe that the coating serves to reinforce the shell (column 3, lines 31-32) and enables a substantially dry coating to be created which does not drawn the water or plasticizer from the gelatin shell (column 1, lines 51-53).

### ***Conclusion***

Due to the new grounds of rejection, this action is made Non-Final.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MELISSA S. MERCIER whose telephone number is



(571)272-9039. The examiner can normally be reached on 8:00am-4:30pm Mon through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward can be reached on (571) 272-8373. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Melissa S Mercier/  
Examiner, Art Unit 1615

/MP WOODWARD/  
Supervisory Patent Examiner, Art Unit 1615